

REMARKS/ARGUMENTS

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided. Upon entry of the present amendment, claims 20, 21, 24, 25, 30, 31, 32 and 34 will have been amended, with claims 19, 23, and 27 standing allowed. Claims 19-27 and 30-35 remain pending. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

Turning to the merits of the action, the Examiner has objected to claims 20 (which should be claim 21), 25, 31, and 34 because of informalities. Without agreeing to the propriety of the objections, by the present amendment, Applicant has amended claim 21, 25, 31 and 34 to address these informalities. Thus, Applicant respectfully requests that the Examiner withdraw the objections.

The Examiner has rejected claims 20, 24, 30 and 33 under 35 U.S.C. § 102(e) as being anticipated by ENDO (U.S. Patent No. 6,801,340). The Examiner has rejected claims 21, 25, 31 and 34 under 35 U.S.C. § 103(a) as being anticipated by ENDO. The Examiner also has rejected claim 22, 24, 32 and 35 under 35 U.S.C. § 103(a), as being unpatentable over ENDO in view of WOLF (U.S. Patent No. 6,535, 303). Applicant respectfully traverses all grounds of the rejections.

As noted above, Applicant has amended (by clarifying the limitations therein) claims 20, 24, 30, and 33 for consideration by the Examiner. Applicant respectfully traverses the above rejection and will discuss said rejection with

respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter, and do not narrow the scope of the claims.

In a non-limiting embodiment, Applicant's independent claim 20 generally relates to an image communication apparatus which has a scanner configured to scan image data and a panel configured to input an address of a recipient. The image communication apparatus of claim 20 has a memory which stores an e-mail address of a management center. The image communication apparatus of claim 20 also has a controller which converts the scanned image data into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to both of the address of the recipient input by the panel and the e-mail address of the management center. Further, the e-mail is independently transmitted to the address of the recipient (*i.e.*, without passing through the management center). The management center of claim 20 further manages information that the image communication apparatus transmits to the address of the recipient input by the panel and further is configured to connect to the image communication apparatus via the Internet. The management center of claim 20 is distinct from the recipient of the address input by the panel, the e-mail address of the management center is independent of the recipient of the address input by the panel, and the e-mail is transmitted to the management center based on the e-mail address stored in the memory and further based on a request to transmit the e-mail to the address of the recipient and a request by a user to transmit the e-mail to the management center. Applicant notes that the present specification

supports an embodiment in which the transmission of the e-mail to the management center is performed based on a request to transmit the e-mail to the address of the recipient and without a request by a user to transmit the e-mail to the management center, for example, at Fig.5, ST501-ST505 (and as further described in Applicant's specification at, *inter alia*, page 8, line 2 – page 10, line 15. Claim 30 recites a generally related method.

In a non-limiting embodiment, Applicant's independent claim 24 generally relates to an image communication apparatus which has a facsimile transmitter configured to transmit image data to a recipient based on a facsimile protocol. The image communication apparatus of claim 24 also has a memory which stores the image data to be transmitted by the facsimile transmitter. The image communication apparatus of claim 24 further has an e-mail transmitter which converts the stored image data into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to a management center based on a request to transmit the e-mail to the address of the recipient and without a request by a user to transmit the e-mail to the management center. The management center of claim 24 manages the e-mail transmitted by the e-mail transmitter and further is configured to connect to the image communication apparatus via the Internet. The e-mail transmitted by the e-mail transmitter corresponds to the image data transmitted by the facsimile transmitter. The management center is independent of the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol. Applicant notes that the present specification supports an embodiment in which

the transmission of the e-mail to the management center is performed based on a request to transmit the e-mail to the address of the recipient and without a request by a user to transmit the e-mail to the management center, for example, at Fig.6, ST601-ST605 (and as further described in Applicant's specification at, *inter alia*, page 8, line 2 – page 10, line 15. Claim 33 recites a generally related method.

With respect to the Examiner's rejection of independent claims 20, 24, 30 and 34 under 35 U.S.C § 102(e), ENDO relates to a data communication apparatus and method that has an address book 301 containing a destination address 401, a transmission method 402 and a data transmission format 403 for transmitting document data to the destination address (Fig.4). A user of the data communication apparatus picks up (or selects) designated destinations from the address book 301, and the destination list generator 300 generates a transmission destination list (Fig.5) based on the designated destinations (col.4, lines 29-35 and lines 51-56). The document transmission controller 302 classifies the transmission destination list based on data transmission format in accordance with document type data 303 (col.4, lines 64-67). The format converter 308 performs format conversion for each group of destination having a common format, in accordance with the data-transmission-format based classification (col.5, lines 30-39).

However, ENDO does not disclose at least that the transmission of the e-mail to the management center is performed based on a request to transmit the e-mail to the address of the recipient and without a request by a user to transmit

the e-mail to the management center. Rather, in ENDO, a user of the data communication apparatus has to manually select designated destinations from the address book 301 for transmissions to designated destinations. In other words, in ENDO, a user has to select each of designated destinations in order to transmit a document to the designated destinations. Thus, in ENDO, in order for the e-mail to be sent to a "management center," the user must manually select or enter the e-mail address of any such "management center," and no e-mail destination is ever automatically selected.

On the other hand, in the present invention, once a user inputs an address of a recipient for transmission of an e-mail to the address of the recipient, the user does not have to input an e-mail address of a management center for transmission of the e-mail to the management center, since the transmission of the e-mail to the management center is automatically performed based on a request to transmit the e-mail to the address of the recipient, irrespective of whether or not the e-mail address of the management center is input.

Thus, independent claims 20, 24, 30 and 34 are clearly patentable over ENDO. Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20, 24, 30 and 34 are not disclosed in ENDO, and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35

U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 20, 24, 30, and 33 and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

With respect to the Examiner's rejection of dependent claims 21, 22, 25, 26, 31, 32, 34 and 35 under 35 U.S.C. § 103(a), since these claims are dependent from an allowable independent claim, which is allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. Applicant further notes that the amendments made to dependent claims 21, 25, 31, and 34 have been made merely to correct a clerical error (in accordance with the Examiner's request). Additionally, Applicant respectfully traverses the Examiner's Official Notice that managing and supervising the database or the file server is well known in the art, and respectfully requests that the Examiner provide support for such Official Notice (by providing, *e.g.*, at least one reference), if the Examiner chooses to maintain this rejection. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103 (a).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has eliminated the basis for the rejection. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this clarifying amendment is being made to advance prosecution of the application to allowance, and with respect to the added claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. For example, as discussed *supra*, the amendments made to dependent claims 21, 25, 31 and 34 have been made merely to eliminate informalities.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Kiyoshi TOYODA

William S. Boshnick
Reg. No. 44,550



Bruce H. Bernstein
Reg. No. 29,027

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191